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Case No.

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1983

THOMAS A. GARDNER,

Petitioner,

vs.

TEC SYSTEMS, INC., a corporation of Wisconsin, and ROY E. DOWNHAM, JACK ECKELAERT and JOHN W. FROST,

Respondents.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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QUESTIONS PRESENTED

1. Where the best prior art was considered by the Patent Office, does the presumption of validity of 35 USC Sec. 282 and Rule 52 of the Federal Rules of Civil Procedure require that the Trial Court make findings pointing out where the Patent Office committed error in granting the patent?

2. Can the presumption of validity be overcome where the scientific evidence before the Trial Court corroborates the evidence before the Patent Office and the Courts below misapprehended the significance of the evidence?

3. Where there was no evidence established to be representative of the prior art, is a holding of invalidity based on non-representative prior art a taking of property without due process of law?

4. Can the presumption of validity

be overcome by test evidence of non-prior art compared with test evidence of the invention?

5. Can there be clear and convincing evidence of invalidity to overcome the presumption of validity where findings are contrary to the only evidence presented?

PARTIES BELOW

All parties are named in the case caption.

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THOMAS A. GARDNER,

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vs.

TEC SYSTEMS, INC., a corporation of Wisconsin, and ROY E. DOWNHAM, JACK ECKELAERT and JOHN W. FROST,

Defendants.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

Petitioner, Thomas A. Gardner, respectfully prays that a writ of certiorari issue to review the judgment entered on January 12, 1984, by the United States Court of Appeals for the Federal Circuit.

OPINIONS BELOW

The District Court held the patent in suit invalid and denied post-judgment motions. Patentee and Plaintiff Gardner appealed from the judgment and denial of post-judgment motions.

The Court of Appeals for the Federal Circuit sitting in banc for the first time in a patent case affirmed the holding of invalidity and declined a request for rehearing. Its decision is reported at 725 F.2d 1338 and 220 USPQ 777.

JURISDICTION

The judgment of the Court of Appeals is dated January 16, 1984. A request for extension of time to file a petition for rehearing to Feb. 6, 1984, was granted and a timely petition for rehearing was declined on March 22 and this petition for writ of certiorari was filed within 90 days of that date. The

jurisdiction of this Court is invoked under 28 USC 1254 (1).

STATUTES INVOLVED

Questions 1, 2 and 4 involve 35 USC 282 which provides in its pertinent portions:

> "A patent shall be presumed valid. Each claim of a patent (whether in independent, dependent, or multiple dependent form) shall be presumed valid independently of the validity of other claims; dependent or multiple dependent claims shall be presumed valid even though dependent upon an invalid claim. The burden of establishing invalidity of a patent or any claim

thereof shall rest on the party asserting such invalidity."

STATEMENT OF THE CASE

Jurisdiction of the Courts below rests on 28 USC 1338 (a) and 28 USC 1291 and 28 USC 1295.

The patent in suit revolutionized the drying art in the process printing business. Prior to the Gardner invention, there was no commercially available apparatus or technique to support, stabilize and position a web freshly printed on both sides and move it through a high velocity air dryer.

Prior art attempts to dry webs printed on both sides by means of high velocity hot air impingement had foundered on the rock of inability to support and transport such a web through a dryer without contact of the web with parts of the apparatus. This contact with web surfaces caused smudging of the ink,

deposit of ink smears on the apparatus, etc. This problem inhibited full utilization of high speed printing presses, for example, which would print on both sides of the web at the same time.

The Gardner invention solved the problem and brought into commercial use an entirely new and commercially practical "high velocity dryer" in which the web is positioned out of contact with any physical structure and transported through the dryer so that ink on both sides of the web may be dried simultaneously. This created a completely new industry and the invention was licensed by Plaintiff Gardner to Overly, Inc. and achieved great commercial success. In the period from 1963 when the invention was introduced into the market until 1969 when the Defendants commenced their infringing activities, the Gardner floater dryer incorporating the web po-

sitioning air bars of the instant invention had captured the major share of the market for dryers in the printing industry.

The web supporting and drying problems that were ultimately solved by the patent in suit are best described in a paper presented by Gardner announcing the Gardner air bar achievement to an International Symposium sponsored by the Canadian Pulp and Paper Association in 1964, contained in file history of the patent in suit (PX 43) Col. 1, page 3:

> "The possibility of using high-velocity air dryers with their tremendous drying capacity on both sides of a web had been an intriguing idea for several years, but there were serious obstacles to doing it. Although it was possible to secure reasonably balanced static pressures above and below a web in opposed high velocity dryers, the extreme turbulence of the high energy air jets caused the web to vibrate wildly at random across its entire expanse."

The prior art Vits patent 3,181,250

was the principal reference in the Patent Office and also at the trial of this action. A Vits dryer had not achieved any commercial success or was not in use in the United States at the time of the trial. Vits taught use of low velocity air to avoid turbulence and wide spacing of the bars from the web to prevent the bar's contact with the web which would smear the ink.

During 1962 Gardner experimented with a large number of web supporting devices, including a construction similar to the Vits patent, and finally, in 1963, came up with the web stabilizer air bar of the patent in suit which enabled use of high velocity air. The air bar formed a uniform zone of superatmospheric pressure spanning the web that positioned and stabilized the web without contact with the air bar.

The key to the invention was the lo-

cation of the suppression plate as close to the floating web as possible and closer than the air nozzles to cause a high rate of pressure drop of the outflowing air. The difference in rate of pressure drop is inversely proportional to the cube of the clearance between web and air bar suppression plate. The difference in pressure drop between Gardner and the prior art was a difference of almost 140 times. It is the tremendous increase in this friction on the outflowing air which maintains positive pressure up to the web edge and eliminates the negative pressure or suction and web contact at the edge of the web found in the prior art Vits patent.

The Gardner patent in Col. 2, lines 5-22 (A 70) provides:

> "In the desired practice of the invention, the clearance between the suppression plate and the web is so slight that the slight loss of pressure resulting from flow

out of the ends of the space does not usually detract measurably from the result. In fact, parallel flow from below and above the web laterally over the free margins at the sides of the web has very important advantages in smoothing out wrinkles or ruffles in the margin, the effect being so pronounced that manual displacement of the margines is followed by restoration of the margin to its initial position with a snap action as if the margin were subject to the action of a spring.

As will be explained, if the suppression plate is far removed from the web the effect will be lost."

Claim 1 (A 72) of the Gardner patent sets forth the parameters for positioning the suppression plate.

"1. Means for positioning a moving web by subjecting a transverse zone spanning the web to uniform static pressure, said positioning means comprising a suppression plate extending transversely across said web and spaced therefrom as closely as is mechanically practicable, nozzle means no closer to the web than said plate and having slots which extend substantially continuously across said web and are spaced at opposite sides of said plate, the minimum spacing between the web and said plate being a distance at least approxi-

mately twice as great as the nozzle slot width, the maximum spacing of the plate from the web never being greater than the width of the plate, the product of the width of the plate and the spacing of the plate from the web being less than twenty times the nozzle slot width, and means for discharging gas under pressure through the nozzle slots for defining a zone of static pressure between the plate and the web."

The Gardner patent (A 67) issued in 1969 and this suit was brought shortly thereafter. Trial of the action was held on various days in 1976 and 1977. The trial was concluded on March 7, 1977, and a decision was rendered on August 2, 1982.

The Trial Court relied principally on the Vits patent in invalidating the claims, notwithstanding its thorough consideration by the Patent Office.

The Vits patent 3,181,250 was the principal art considered by the Court in holding the patent invalid. In Finding 71 (A 50), that Court stated:

"By far the most pertinent prior art which must be considered by the Court is the Vits patent No. 3,181,250 (DX304)".

The Vits '250 patent was thoroughly considered in the Patent Office over a period of six years and was relied upon as the principal reference by Examiners John Camby and Frederick L. Matteson, Jr., in at least five actions rejecting the claims in the series of three applications which eventually resulted in the patent in suit. The Vits '250 patent was also the principal reference discussed in a fifteen page appeal brief. Subsequent to the filing of the brief, the claims in suit were allowed after a conference between Examiner Matteson and conferee examiners H. B. Ramey and James W. Werthauer.

DECISION OF THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The Court of Appeals affirmed the

holding of invalidity based on the Vits patent.

The Court of Appeals stated on page 14 (A 14):

> "35 USC 103, as applied by the Supreme Court in Graham v. John Deere, makes the factual inquiry into the scope and content of the prior art the appropriate starting point for consideration of obviousness. Thus, we start with the trial court's essentially unchallenged finding that Vits is unquestionably the most pertinent prior art. After painstaking review of the opinion of the trial court and the briefs on appeal, we have found neither a finding nor a contention which suggests that any of the remaining references teach anything not found in Vits. We therefore premise our reasoning, as did the trial court in essence, on Vits."

On page 16 (A 16):

> "As for the standard of proof TEC had to meet to prove it, we note that the claims were allowed over Vits, and that no reference shows more than does Vits. It is thus perfectly clear that TEC in effect asked the trial court to cover precisely the same ground as that covered by the PTO in its quasi-judicial determination of patentability that it is authorized and required by statute to render.

Therefore, TEC's burden on this point was a heavy one."

The Trial Court's evidentary basis for invalidating the Gardner patent was that comparative tests of invention vs. prior art did not demonstrate a difference in kind or performance of the invention vs. the prior art.

During prosecution of the patent application in the Patent Office, Gardner submitted comparative tests of a Gardner air bar and a Vits air bar. Gardner attempted to show the difference between the close positioning of the suppression plate in the Gardner air bar with the wide spacing in Vits. The test curves are reprinted on page 19 (A 19) of the Court of Appeal's decision. The Trial Court regarded these tests as non-probative (Finding 38, A 37) because the Vits bar had a nozzle slot width approximating the dimension of the Gardner test bar rather than being scaled from the

drawings of Vits patent. It was error for the Court to rely on the scale of patent drawings where the dimensions or scale are not identified in the specification. In re Chitayat (CCPA 1969), 408 F.2d 475, 161 USPQ 224, 226. Moreover, TEC admitted that the Vits patent drawings were not to scale. Incredibly, the Court of Appeals in referring to the problem of scale of the Vits test bars and ignoring the fact that the Vits patent drawings were not to scale and could not be relied upon, stated (A 23):

> "The fact is that Gardner changed the Fig. 10 nozzle dimensions in building his version of Vits bar and it was for the Trial Court to evaluate the probative weight to assign to the tests which were made with it. We cannot find reversible error in the Trial Court's evaluation of that test evidence on a fact issue."

The Trial Court disregarded the Patent Office tests but relied heavily

on the "wooden block tests" at the trial as showing an absence of any difference in characteristics between a Gardner air bar and a Vits air bar. However, the Trial Court misapprehended the Vits air bar used in the wooden block tests and was of the belief that it was scaled from the patent drawings, when, in fact, it was an air bar with the same dimensions as the Vits bar tested by Gardner before the Patent Office. Hence, on the one hand the Court rejected Plaintiff's file wrapper tests as not probative but accepted Defendants' tests with the same equipment which also was not copied to the scale of the patent drawings of Vits under the misapprehension that the Vits air bars used in the tests were scaled from the drawings.

The Court of Appeals recognized that the Trial Court misapprehended the character of the Vits air bar used in the

wood block tests by its statement referring to the wood block tests (A 21):

> "At trial, Gardner was also able to elicit from Dr. Dane additional testimony about the pressure at the web edges, which confirmed that a Gardner version of Vits produces suction there." (emphasis supplied)

Hence, the Court of Appeals recognized that even with the wood block tests there was negative pressure at the web edges with the Vits air bar but neither Court understood the significance of the negative pressure in the prior art Vits device.

Gardner characterized the negative pressure of Vits in the file wrapper as follows:

> "Exhibit 4 shows that it is impossible in the use of the Vits nozzle heads to achieve any uniformity or stability. A negative pressure at the margin of a web is a factor which leads to great instability and may result in frictional contact of the web with the nozzle. The same result follows from the fact that

> the pressure does not stay uniform across the width of the web, since a point at which the pressure is relatively high at one face of the web may be opposite to a lower pressure at the other face of the web, thereby causing flexing and bodily displacement of the web, in some case contacting the nozzle head."

Negative pressure or suction renders an air bar inoperable because it causes the web to hit the bar and smear the ink. Suction at the web edge is a fatal defect. Yet the Court of Appeals found no error with the Trial Court's finding 75 (A 53):

> "The evidence at trial never showed that the departing from the dimensional limitations would necessarily cause an air bar to function or fail."

Finding 86 (A 59):

> "The dimensional limitations of Gardner's '477 are essentially meaningless."

All tests of Vits bars before the Court with the plate between the nozzles widely spaced from the web, and outside

of the claim dimensional limitations whether they were file wrapper tests or Defendants' wood block tests, showed negative pressure or suction at the web edge and hence failure. In the face of all the evidence, the foregoing findings of the Trial Court are unsupportable by any quantum or quality of evidence.

Hence, not only were the Courts below in error in rejecting Gardner's tests in the Patent Office, the Trial Court based its decision of "no difference between invention and prior art" on tests of non-prior art, i.e., a bar not scaled from or otherwise established to be representative of any prior art.

REASON FOR GRANTING THE WRIT

Plaintiff GArdner has not been accorded the benefit of the presumption of validity. In possibly the last reference to the presumption of validity by

this Court, this Court said in Blonder-Tongue Lab., Inc. v. University of Illinois Found. (1971) 402 U.S. 313, 334, 91 S.Ct. 1434, 1446:

> " * * * patentees are heavily favored as a class of litigants by the patent statute. Section 282 of the Patent Code provides, in pertinent part:
>
> > 'A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it.'
>
> If a patentee's expense is high though he enjoys the benefits of the presumption of validity, the defendant in an infringement suit will have even higher costs as he both introduces proof to overcome the presumption and attempts to rebut whatever proof the patentee offers to bolster the claims."

The Court of Appeals recognized that the Trial Court did not structure its analysis of validity around the presumption.

The Court of Appeals in referring to the Trial Court's opinion and its only

reference to the presumption of validity stated on page 18 (A 18):

> "This last-quoted passage is especially significant in that it contains the trial court's only mention of the presumption of validity. Despite its awareness of controversy concerning the presumption, the trial court never concluded: (1) whether Carlisle had in fact been considered by the examiner; (2) whether Carlisle shows anything not shown in Vits, which was exhaustively considered by the examiner; (3) who had the burden of proving facts concerning validity or invalidity at trial; and (4) by what standard of proof those facts had to be shown."

The generalized statements in prior decision of this Court relating to the presumption of validity are of no aid to the Trial Courts in applying the presumption of validity. Specific guidelines of this Court as to certain mandatory fact findings should be required to implement the congressional intent expressed in 35 USC 282.

In Graham v. Deere, 383 US1 86,

S.Ct. 684, this Court set up the guidelines for fact findings required to analyse the obviousness vs. non-obviousness issue of 35 USC 103.

This Court did not set forth any guidelines to implement the presumption of validity where the Patent Office considered the best prior art as in the present case.

The presumption was, originally, the creation of the Courts and was a part of the judge-made body of patent law when the Patent Act of 1952, Title 35, was written. That act, for the first time, made it statutory in §282, first paragraph, which, before the amendments of 1965 and 1975, was the utmost simplicity. It read:

> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on the party asserting it."

The reviser's note to that section simply

said:

> "The first paragraph declares the existing presumption of validity of patents"

This was a modification of sorts, replacing the conflicting case law with one simple statutory declaration. In his Commentary on the New Patent Act by P. J. Federico, principal author of the act, published in 35 USCA, page 54, the author expands somewhat on the reviser's note, saying:

> "The first paragraph of section 282 declares that a patent shall be presumed valid and that the burden of establishing invalidity of a patent shall rest on a party asserting it. That a patent is presumed valid was the law prior to the new statute, but it was not expressed in the old statute. The statement of the presumption in the statute should give it greater dignity and effectiveness."

In 1952 the case law was far from consistent -- even contradictory -- about the presumption and, absent statutory restraint, judges were free to express

their individual views about it. The foundation for the presumption of course was the basic proposition that a government agency such as the Patent Office was presumed to do its job. Morgan v. Daniels, 153 U.S. 120, 125 (1894). On the burden of persuasion in the face of such a presumption, long before enactment of the present statute, the Supreme Court reviewed the situation in Radio Corp. v. Radio Laboratories, 293 U.S. 1 (1934), noting (p. 7) that the force of the presumption "has found varying expression in this and other courts." Justice Cardozo, after reviewing a variety of expressions of the standard of proof required to overcome the presumption of validity and while noting that "Gradations of difference so subtle are not susceptible of pursuit without leading us into a land of shadows," concluded (p. 8):

> "Through all the verbal variances, however, there runs this common core of thought and truth, that one otherwise an infringer who assails the validity of a patent fair upon its face bears a heavy burden of persuasion, and fails unless his evidence has more than a dubious preponderance."

When no prior art other than that which was considered by the Patent Office Examiner is relied on by the attacker of validity, the attacker should have the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job. This deference is required because the Examiners have expertise in interpreting the references, are specially trained in the technical area in the art involved, and familiar with the level of skill in the art. Moreover, it is their duty to issue only valid patents pursuant to 35 USC 131 which provides:

> "The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commission shall issue a patent therefor."

In the manual of Patent Examining Procedure, Sec. 706, the Examiners are admonished:

> "Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case."

The manual then quotes from this Court's decision in Graham v. Deere. Hence, where the prior art is the same, the same law and facts considered by the Court are considered by the Examiners in the Patent Office.

The 1952 Act and the new statute 35 USC 282 did nothing to eliminate the confusion as to the burden of proof and quantum of evidence necessary to overturn the Patent Office decision and the

proper technique to apply presumption of validity. Where the best prior art was cited and considered by the Patent Office, the various Circuits consider the presumption strengthened. Professor Chisum, in his treatise on Patents, page 5-272, Sec. 5.06 (2) cites and footnotes the following cases for a "strengthened presumption" in footnote 9:

> "Milgo Elec. Corp. v. United Business Communications, Inc., 623 F.2d 645, 206 U.S.P.Q. 281 (10th Cir. 1980); Hanson v. Alpine Valley Ski Area, Inc., 611 F.2d 156, 159, 204 U.S.P.Q. 803 (6th Cir. 1979); Universal Athletic Sales Co. v. American Gym, Recreational & Athletic Equip. Corp., 546 F.2d 530, 540 n. 28, 192 U.S.P.Q. 193 (3d Cir. 1976); CMI Corp. v. Metropolitan Enterprises, Inc., 534 F.2d 874, 880, 189 U.S.P.Q. 770 (10th Cir. 1976); Ortho Pharmaceutical Corp. v. American Hosp. Supply Corp, 534 F.2d 89, 190 U.S.P.Q. 397 (7th Cir. 1976) ('the usual presumption of validity under 35 U.S.C. § 282 is strengthened when the Patent Office specifically considered the prior art which is urged to invalidate the by an accused infringer.');

LaSalle Street Press, Inc. v. McCormick & Henderson, INc., 445 F.2d 84, 93, 170 U.S.P.Q. 305 (7th Cir. 1971) ('The presumption of validity is strengthened where the prior art asserted against validity is no better than that considered and rejected by the Patent Office.'); Stamicarbon, N.V. v. Escambia Chem. Corp., 430 F.2d 920, 926, 166 U.S.P.Q. 362 (5th Cir. 1970); Scaramucci v. Dresser Indus., Inc., 427 F.2d 1309, 1313, 165 U.S.P.Q. 759 (10th Cir. 1970); Nasco Inc. v. Vision-Wrap, Inc., 352 F.2d 905, 908, 147 U.S.P.Q. 297 (7th Cir. 1965); Coal Processing Equip., Inc. v. Campbell, 211 U.S.P.Q. 986 (S.D. Ohio 1981) ('In application this doctrine has meant that prior patents that were disclosed to the Patent Office cannot serve as prior art sufficient to support a finding of obviousness.'); Gruendler Crusher & Pulverizer Co. v. Williams Patent Crusher & Pulverizer, 496 F.Supp. 1385, 210 U.S.P.Q. 89 (E.D. Mo. 1980); Bandag, Inc. v. Lewis General Tires, Inc., 207 U.S.P.Q. 745, 755 (W.D.N.Y. 1980); Entec Plastics Engineering Corp. v. Gates Rubber Co., 206 U.S.P.Q. 524 (D. Colo. 1980); Landes Mfg. Co. v. Chromodern Chair Co., 203 U.S.P.Q. 337 (C.D. Cal. 1978); Dennison Mfg. Co. v. Ben Clements & Sons, Inc., 467 F.Supp. 391, 407, 203 U.S.P.Q. 895 (S.D.N.Y. 1979); Remington Arms Co. v. Funasaw Co., 201 U.S.P.Q. 217 (N.D. Ill. 1978); Deere & Co. v. International Harvester Co., 460 F.Supp. 523,

200 U.S.P.Q. 150 (S.D. Ill. 1978) reversed and remanded 618 F.2d 110 (7th Cir. 1980) (without published opinion) on remand 496 F.Supp. 397, 208 U.S.P.Q. 158 (C.D. Ill. 1980) aff'd 658 F.2d 1137, 211 U.S.P.Q. 11 (7th Cir. 1981) ('presumption cannot be overcome by reliance on prior art . . . having no greater pertinency than that which the Examiner rejected in his allowance of the patent,'); Pate Co. v. RPS Corp., 200 U.S.P.Q. 571 (N.D. Ill. 1978) rev'd 685 F.2d 1019 (7th Cir. 1982); Arco Indus. Corp. v. Chemcast Corp., 200 U.S.P.Q. 491 (E. Mich. 1977); Wilden Pump & Eng'r Co. v. Pressed & Welded Prod. Co., 199 U.S.P.Q. 390 (ND. Cal. 1978) aff'd 655 F.2d 984, --U.S.P.Q. -- (9th Cir. 1981); Rohm & Haas Co. v. Owens-Corning Fiberglass Corp., 196 U.S.P.Q. 726 (N.D. Ala. 1977); Teledyne Indus., Inc. v. Windmere Prods., Inc., 433 F.Supp. 710, 195 U.S.P.Q. 354 (S.D. Fla. 1977) ('This fact that the prior art cited was before the Patent Office for consideration strengthens the presumption of validity accorded this second patent.')"

The Court of Appeals for the Federal Circuit has taken the position that the presumption of validity is a procedural device not substantive law. In Stratoflex Inc. v. Aeroquip Corp.,

(Fed. Cir. 1983) 713 F.2d 1530-1534,

the Court stated:

> "The presumption, like all legal presumptions, is a procedural device, not substantive law. It does require the decisionmaker to employ a decisional approach that starts with acceptance of the patent claims as valid and that looks to the challenger for proof of the contrary. Thus the party asserting invalidity not only has the procedural burden of proceeding first and establishing a prima-facie case, but the burden of persuasion on the merits remains with that party until final decision. The party supporting validity has no initial burden to prove validity, having been given a procedural advantage requiring that he come forward only after a prima-facie case of invalidity has been made. With all the evidence in, the trial court must determine whether the party on which the statute imposes the burden of persuasion has carried that burden."

In the instant case the Court stated as noted above that Defendants' burden was a heavy one. Phrases such as a "heavy burden" are of no aid to a Trial Court in approaching the obviousness - non-obviousness issue where the best

prior art was considered by the Patent Office.

It is apparent from the decision of the Court below that the Trial Court after briefly mentioning the presumption of validity proceeded to analyze patentability (Findings 62-65) (A 46-48) and determine de novo whether the Gardner patent met the requirements or characteristics for patentability of synergism and non-obviousness rather than determine where the Patent Office committed error in granting the patent.

In Finding 87 (A 59), the Court concluded after having proceeded through the analysis required under Graham v. Deere, the claims would have been obvious.

This is contrary to 35 USC 282. The statute requires that the court begin by presuming that the invention has characteristics of patentability. To do otherwise is to ignore the statute and

to place on the patentee a non-statutory burden of proving validity and proving that the Patent Office decision was correct.

The absence of any guidelines on applying the presumption of validity has resulted in the Court's struggle with the technical issues and the gross misapprehension as to the character of the Vits wood block test model and the judgment based thereon on "non-prior art". The judgment of invalidity is so devoid of evidentary support as to be an unconstitutional deprivation of property. Thompson v. City of Louisville, (1960) 362 U.S. 199, 80 S.Ct. 624.

Where "fraud on the Patent Office" is alleged, detailed findings are required to sustain the defense and a finding on "materiality" of the representations are required. Plastic Container Corp. v. Continental Plastics

(CA-10, 1979) 606 F.2d 885, 203 USPQ 27, 38.

The jurisprudence regarding the tests for patentability and "fraud on the Patent Office" is more fully developed than that for applying the presumption of validity. A Trial Court is required to make Graham findings as enunciated by this Court in Graham v. Deere on the obviousness - non-obviousness issue or be subject to reversal and remand for such findings. Palmer v. Orthokinetics, Inc. (CA-9, 1980) 611 F.2d 316, 204 USPQ 893. This Court could and should promulgate fact finding requirements which would aid the Trial Courts in applying the presumption, particularly where the Patent Office had the best prior art before it. For example, the Trial Courts, once they make a finding that the prior art before the Court is no more perti-

nent than that before the Patent Office, should be required to make the following findings where appropriate before overturning the Patent Office, pointing out:

(1) where the Patent Examiner went wrong and misinterpreted the prior art,

(2) where the Patent Examiner went wrong in misunderstanding the technology in the patent application,

(3) where the Patent Examiner went wrong in misunderstanding the claims and allowing claims which fail to distinguish from the prior art,

(4) where the Patent Examiner went wrong in allowing claims which do not distinctly point out the invention,

(5) where the Patent Office went wrong in relying on certain facts submitted by applicant to support allowance,

(6) why the errors of the Examiner

were material to allowance of the patent and justify a holding of invalidity.

While the Court of Appeals for the Federal Circuit will create uniformity in the patent law, it is up to this Court to improve administration of the patent laws by the Lower Courts.

In the absence of any guidelines regarding fact finding requirements, patents in highly technical areas could be invalidated by the Courts on the same evidence, which was fully understood by the Patent Examiners. Under these circumstances, Congress has endeavored to carry out the public interest by enacting 35 USC 282. The aim of the patent system of enforcibility of meritorious patents should not be frustrated by the inability of the judiciary to apprehend the scientific principals involved.

CONCLUSION

For the foregoing reasons, the Petition for Writ of Certiorari should be granted and the judgment of the Court of Appeals should be reversed. The administration of our patent laws requires a definitive pronouncement by this Court on the application of the presumption of validity. This is necessary to maintain the confidence of businessmen in the patent system, the main objective of the sponsors of the bill which created the Court of Appeals for the Federal Circuit.

Respectfully submitted,

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